

REMARKS

In the application claims 1, 2, and 5-19 remain pending. Claims 3 and 4 have been canceled as being drawn to a non-elected species of the invention. The claims have been amended to clarify what is regarded as the invention. Support for the amendments may be found in the specification and figures as originally filed and, as such, no new matter has been added.

In the Office Action, claims 1-2 and 5-19 were rejected under 35 U.S.C. § 103 as being rendered obvious over Tessier (U.S. Patent No. 5,629,868) in view of Beery (U.S. Patent No. 5,963,269). The reconsideration of this rejection of the claims is respectfully requested.

It is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that the combination of references being relied upon disclose the claimed invention “as a whole.” The requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, *with no knowledge of the claimed invention*, would have selected the various parts from the references and combined them in the claimed manner.

With this requirement for maintaining an obviousness rejection in mind, it is submitted that neither Tessier nor Berry include any disclosure that can be said to demonstrate that an artisan of ordinary skill in the art would have modified Tessier to arrive at the invention claimed.

Considering Tessier, it is submitted that Tessier fails to disclose, teach, or suggest the desirability of transmitting from a display screen to a remote control, via screen flashes or any other means, information that functions to identify a channel determined as currently being tuned to as is set forth in the claims. Rather, as acknowledged in the Office Action, Tessier discloses the desirability of transmitting from a display screen to a remote control, via screen flashes, nothing more control codes for use in controlling a controllable appliance. The control codes “define a list of appliances that are controllable as well as their control sequences.” (Col. 2, lines 36-37). Additionally, a user may select a program that the user desires to record and then download into the remote control the control codes required to record that program at the time that program is to air. (Col. 7, lines 35-57). While the control codes required to record a program *in the future* may specify a channel to tune to *in the future* to allow said program to be recorded, nowhere does Tessier disclose, teach, or suggest that the downloadable control codes required to record a program have *any* nexus to a channel or program *currently* being watched. Simply stated, **nowhere does Tessier disclose, teach, or suggest that the information provided to the remote control for any purpose, including the purpose of recording to-be-aired programs, is provided considering a channel determined as currently being tuned to, i.e., the channel being viewed when a request for that information is received, as is expressly required by the claims.** Therefore, since it cannot be argued

that screen flashes used for the purpose of teaching control codes to a remote control, including control codes to command a VCR to record a program at a future time, discloses, teaches, or suggests providing to a remote control information that functions to specify a channel to which an appliance is determined to be currently tuned to, as is set forth in the claims, the rejection of the claims must be withdrawn.

Considering now Beery, it is submitted that Beery cannot be said to suggest modifying Tessier to arrive at the invention set forth in the claims. While Beery discloses a system having a favorite channel scan list, Beery expressly discloses that the channels are assigned to the favorite channel scan list by a user activating keys of the remote control to designate the channel number (step 378 of Fig. 7) followed by activation of an “enter” key (step 380 of Fig. 7) which functions to store (step 336 of Fig. 7) the designated channel number in memory. Berry does not, however, disclose, teach, or suggest the desirability of using information provided from a source outside of the remote control, e.g., a display using screen flashes to convey information that functions to specify a channel an appliance is currently tuned to, to populate the favorite channel scan list. As such, the mere disclosure within Barry of “favorite channel scan list” cannot be said to support a rejection under 35 U.S.C. § 103, i.e., nothing from Berry can be said to suggest the modification of Tessier to include within Tessier those claim elements which neither Tessier nor Berry disclose. For this additional reason it is submitted that the rejection of the claims must be withdrawn.

In sum, since both Tessier and Berry fail to disclose, teach, or suggest at least the claimed element of providing to a controlling device information that functions to identify a channel an appliance is determined as currently being tuned to, the combination

of Tessier and Berry cannot be said to present a *prima facie* case of obviousness. Similarly, for the reason that Berry also fails to disclose, teach, or suggest the desirability of using an appliance, and more particularly information received from an appliance, to create a list of favorite channels, nothing from Berry can be said to suggest the modification of Tessier to arrive at the invention set forth in the claims.

CONCLUSION

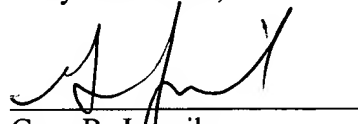
It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

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